

REMARKS

The Examiner is thanked for the thorough examination of the present application. The Office Action, however, has tentatively rejected all pending claims. Specifically, the Office Action has rejected all claims under 35 U.S.C. § 103(a) as allegedly unpatentable over the combination of U.S. patent 5,980,183 to Fosnight in view of U.S. patent 3,698,326 to Schurch and U.S. patent 6,283,692 to Perlov. In this response, Applicants have amended independent claims 1, 13, and 23 to specify that the horizontal portion is higher than the conveying system. Applicants submit that this feature clearly defines the claimed embodiments over the cited art of record. Thus, as amended, the rejections of independent claims 1, 13, and 23 (as well as dependent claims 2-6, 10, 14-15, and 19) have been rendered moot.

Turning to independent claim 22, which was not amended herein, claim 22 recites:

22. An intra-bay delivery system comprising:
a wafer carrier;
a load port supporting the wafer carrier;
a conveyor, disposed above the load port;
a rail having vertical and horizontal portions, wherein the vertical portion extends from the load port *and the horizontal portion is located above the conveyor*; and
a robot including a roller movably disposed on both the vertical and horizontal portions of the rail to transfer the wafer carrier between the load port and the conveyor and a holding portion having a first end holding the wafer carrier and a second end disposed on the roller, wherein the first end holding the wafer carrier is a flange.

(Emphasis Added).

As is clearly emphasized above, claim 22 requires that the horizontal portion of the delivery system is located above the conveyor. The cited art fails to teach this feature. Indeed, the Office Action did not even allege this feature to be embodied in the cited art. In this regard, the Office Action alleges that Schurch discloses a horizontal portion. Although Applicants

disagree with this broad application of *Schurch*, Applicant more particularly submit that *Schurch* does not disclose a "horizontal portion" being "located above the conveyor," as specifically required by claim 22. For at least this reason, the rejection is misplaced and should be withdrawn.

Independent claims 1, 13, and 23 have each been amended to include this same feature. Therefore, for at least the same reason as claim 22, the rejections of claims 1, 13, and 23 should be withdrawn. As each independent claim defines over the cited art, the dependent claims patently define over the art for at least the same reasons.

As a separate and independent basis for traversing the 103 rejections, Applicants respectfully submit that the Office Action has failed to cite a proper motivation or suggestion for combining the cited references. In this regard, the Office Action stated only that the combination of *Schurch* with *Fosnight* would have been obvious "such that during conveying a carrier is maintained in vertical position." (Office Action, p. 3). Similarly, the Office Action stated only that the combination of *Perlov* with *Fosnight* would have been obvious "to drive a robot vertically and horizontally." These alleged motivations are clearly improper in view of well-established Federal Circuit precedent.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether

such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicants notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive a load port transfer device, as claimed by the Applicants.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular." Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).

Merely identifying some benefit (from hindsight) that results from a combination is not sufficient to justify the combination, and the motivation or suggestion must come from the prior art itself, and the Office Action has failed to identify such a motivation. As stated above, the Office Action stated only that the combination of *Schurch* with *Fosnight* would have been obvious “such that during conveying a carrier is maintained in vertical position.” (Office Action, p. 3). Similarly, the Office Action stated only that the combination of *Perlov* with *Fosnight* would have been obvious “to drive a robot vertically and horizontally.” These are not really even rationales at all. Instead, they appear only to be justifications based on the claimed utility (advanced with the benefit of hindsight). Under the approach adopted by the Office Action, it would always be possible to reject claims simply by relying on the utility of the claimed invention as providing the motivation to combine the cited references. Clearly, this approach is at odds with the well established precedence of the Federal Circuit.

For at least the additional reason that the Office Action failed to identify proper motivations or suggestions for combining the various references to properly support the rejections under 35 U.S.C. § 103, those rejections should be withdrawn.

Cited Art of Record

The cited art of record has been considered, but is not believed to affect the patentability of the presently pending claims.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

No fee is believed to be due in connection with this Amendment and Response. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

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